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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,665	11/21/2003	Barry M. Rosenbaum	0-010173USWF	1326

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EXAMINER	
WATKINS III, WILLIAM P	

ART UNIT	PAPER NUMBER
1772	

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/719,665	ROSENBAUM ET AL.	
	Examiner	Art Unit	
	William P. Watkins III	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 November 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-29* is/are pending in the application.

4a) Of the above claim(s) *23-29* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-29* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *12 April 2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The examiner notes that the claims have been renumbered under 37 CFR 1.126, as claim number 9 was missing from the original presented claims. Claims 1-29 are currently pending.

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-22, drawn to a dry-erasable composite, classified in class 428, subclass 141.

II. Claims 23-27, drawn to a process for making a low-gloss dry-erasable composite, classified in class 427, subclass 257.

III. Claims 28-29, drawn to a dry-erasable composition, classified in class 525, subclass 437.

3. The inventions are distinct, each from the other because of the following reasons:

4. Inventions Group II, claims 23-27 and Group I, claims 1-2 are related as process of making and product made. The inventions are distinct if either or both of the following can

be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed could be made by a materially different process such as by forming a lamination of the first and second layers then forming the microroughened by surface by embossing the reverse surface of the second layer.

5. Inventions Group I, claims 1-22 and Group III, claims 28-29 are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because claim 1 provides evidence that the instant low gloss composite can be made with out the composition of claim 28 . The subcombination has separate utility such as a dry erasable coating without a second microroughened layer.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and since the fields of search are not co-extensive, restriction for examination purposes as indicated is proper.

7. During a telephone conversation with Mr. Dale Bjorkman on 4 February 2005 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-22. Affirmation of this election must be made by applicant in replying to this Office action. Claims 23-29 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-6 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Hasegawa et al. (U.S. 4,123,590).

See the Figure and Examples 2-6, col. 5, line 60 through col. 6, line 5. The reference teaches a roughened surface below a top transparent layer on both the top and the bottom of surface 4 of an erasable board.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claims 1-4, 8, 9, 12-13 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frech (U.S. 3,549,463) in view of Hasegawa et al. (U.S. 4,123,590).

Frech teaches an erasable surface layer of a fluorine based compound on a flexible vinyl substrate with regular embossing on the top surface to reduce gloss (col. 1, line 65 to col. 2, line 15). Hasegawa et al. teach a roughened layer with a micron level roughness under a top transparent erasable layer in order to reduce gloss using a top layer of lesser roughness than the intermediate layer (see the Figure and Examples 2-6, col. 5, line 60 through col. 6, line 5). The instant invention claims a microroughened layer under a top erasable layer. It would have been obvious to one of ordinary skill in the art to roughen the inner layer of Frech with an ordered pattern in the micron range in order to have good gloss reduction without an outer roughened surface because of the teaching of Hasegawa et al. Variation in the gloss level by adjustment of the degree of roughness would have been obvious depending on the expected lighting conditions in the final application.

13. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frech (U.S. 3,549,463) in view of Hasegawa et

al. (U.S. 4,123,590) as applied to claims 1-4, 8, 9, 12-13 and 20 above, and further in view of Callicott et al. (U.S. 6,423,418 B1).

Callicott et al. teaches an oxetane based polymer with fluorine pendant groups as a good erasable layer (abstract). The instant invention teaches an erasable low gloss laminate with an oxetane based polymer in the outer layer. It would have been obvious to one of ordinary skill in the art to have used an oxetane based polymer layer as the top layer of Frech as modified above in order to have a good erasable surface because of the teachings of Callicott et al.

14. Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frech (U.S. 3,549,463) in view of Hasegawa et al. (U.S. 4,123,590) further in view of Callicott et al. (U.S. 6,423,418 B1) as applied to claims 1-4, 8, 9, 12-13, 20 and 14-16 above, and further in view of Fay et al. (U.S. 2003/0138650).

Fay et al. teach the use of co-etherification of melamine to produce a crosslinker that produces a better adhering coating to flexible substrates when used with oxetane based polymer systems (sections 0003, 0016 and the abstract). The instant

invention claims a oxetane based outer coating layer with a melamine with co ethers. It would have been obvious to one of ordinary skill in the art to have used a melamine with co ethers to cross link the oxetane based polymer system of Fay et al. as modified above in order to have better adherence to the flexible vinyl substrate of the combination.

15. Claims 7, 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frech (U.S. 3,549,463) in view of Hasegawa et al. (U.S. 4,123,590) as applied to claims 1-4, 8, 9, 12-13 and 20 above, and further in view of Murata et al. (U.S. 6,261,665 B1).

Murata et al. teaches the use of an acrylic containing radiation crosslinked roughened layer to prevent glare on top of a substrate that is covered in turn by a fluorine containing layer that prevents staining (col. 5, line 10 through col. 10, line 20, abstract, see col. 7, lines 17 for a urethane acrylate). The instant invention claims a radiation cured roughened layer under an erasable top layer. It would have been obvious to one of ordinary skill of the art to have formed the roughened inner layer of Frech as modified above by use of a

radiation cured acrylic material as an alternative to embossing because of the teachings of Murata et al.

16. Claims 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frech (U.S. 3,549,463) in view of Hasegawa et al. (U.S. 4,123,590) as applied to claims 1-4, 8, 9, 12-13 and 20 above, and further in view Korane et al. (U.S. 2004/0077497 A1).

Korane et al. teach the use of adhesive and release layers on the back of erasable coated substrates in order to allow for ease of placement (abstract, claims 1 and 7). The instant invention claims an erasable substrate with an adhesive backing and a release layer. It would have been obvious to one of ordinary skill in the art to have used adhesive and a release layer on the back of Frech as modified above in order to have ease of placement of the laminate because of the teachings of Korane et al.

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Vanderwer et al. teaches a macro structure under an erasable layer. Berkman teaches surface embossing on top of an erasable layer.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Watkins III whose telephone number is 571-272-1503. The examiner works an increased flex time schedule, but can normally be reached Monday through Friday, 11:30 A.M. through 8:00 P.M. Eastern Time. The examiner returns all calls within one business day unless an extended absence is noted on his voice mail greeting.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR of Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WW/ww
May 1, 2005

WILLIAM P. WATKINS III
PRIMARY EXAMINER